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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,692	09/30/2003	Stephen H. Roby	T-6172A (538-58)	5082

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,692

Applicant(s)

ROBY ET AL.

Examiner

Joseph D. Anthony

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9, 11, 12, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 11-12 and 30-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL REJECTION AFTER FILING RCE

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 9, 11-12 and 30-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended independent claim 1 contains new matter in regards to the newly added limitation of: "wherein a tackifier is not present in the composition". Newly added independent claim 31 contains new matter in regards to the limitation of: "wherein a tackifier and a hindered phenol antioxidant are not present in the composition". Nowhere in applicant's remarks filed with the amendment, did applicant attempt to show support in the originally filed specification for said specific claim limitations. After a detailed review of applicant's specification, the examiner can find no support at all for said claim limitations, and thus deems them to be new matter. In fact, the word "tackifier" is never directly used anywhere in applicant's specification. Furthermore, while applicant's specification does mention "hindered phenols", they are disclosed in the **context of being examples of useful other oxidation-corrosion inhibitors FOR applicant's claimed composition!**

see page 27, lines 18-21 of the specification. Claims 2-5, 9, 11-12 and 30 are being rejected here because they are dependent on a rejected base claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 9, 11-12 and 30-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Field et al. WO 99/18175.

Field et al. teaches a synthetic ester-containing lubricant with good soot-handling, see abstract. The ester additive is a polyol ester, preferably trimethylolpropane esterified by mixed C8 to C10 alkanolic acids. The concentration of the polyol ester additive is from 5 to 50 % by weight of the total lubricant composition, see page 5. The synthetic ester-containing lubricant may further comprise known additives such as: viscosity modifiers, corrosion inhibitors, oxidation inhibitors, dispersants, anti-foaming agents, pour point depressants etc., see page 16. Applicant's claims are deemed to be anticipated over said disclosure of the reference. Please note that it is notoriously well known in the art that synthetic lubricants, minus optional additives, are made free of

phosphorous and sulfur. As such, the synthetic lubricant used in the examples of the reference does not contain any phosphorous or sulfur.

In the alternative, Field et al. could be said to differ from applicant's claimed invention in that there is not a direct teaching (i.e. by way of a specific example) to a synthetic lubricating oil composition that actually comprises applicant's component (b) (i.e. polyol ester) within applicant's particular claimed concentration range of claims 1-5 and 9-12. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since the reference directly discloses that the concentration amount for the trimethylol propane ester solublizer of C₈ to C₁₀ carboxylic acid is 5 to 50wt.%, see page 5.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5, 9, 11-12 and 30-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 11/046,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are a subset of the pending claims in S.N. 11/046,994.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed 8/31/07 with the Amendment have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next. The

previously made prior-art rejections made over Culpon, Jr. U.S. Patent Number 5,151,205, have been dropped in light of applicant's New Matter limitation of: "wherein a tackifier is not present in the composition". If applicant were to remove said New Matter limitation from independent claims 1 and 30, the previously made prior-art rejections over Culpon, Jr. would need to be reinstated. In any case, applicant's arguments in the REMARKS section of the amendment that: "Thus, the lubricating oil composition as presently set forth in amended claim 1 would not even contemplate a tackifier therein." (see page 7, lines 18-19) is not accepted by the examiner. The reasons for this is because Culpon's required tackifier component clearly reads on applicant's claimed additives, such as friction modifiers, and viscosity index improver. On page 18, line 18 to page 19, line 4 of applicant's specification, applicant clearly teaches polymers and copolymers as viscosity index improvers. Culpon's polybutene tackifier species clearly falls within applicant's generic disclosure of viscosity index improvers. Furthermore, many other of applicant's claimed functional additives would also seem to read on Culpon's tackifier component since such a tackifier could function as a corrosion-inhibitor, an anti-icing agent, a pour point depressant etc., even if such functions are not directly taught by the reference.

In regards to the above prior-art rejections made over Field et al. it is clear from applicant's remarks that applicant has misread the scope of the Field et al's invention when applicant insists that Field et al's invention requires: "three essentially components: (1) a lubricating oil, (2) a polyol ester and (3) a hindered phenol as an antioxidant" see page 8 of the REMARKS. A quick look at Field et al's independent

claim 1 clearly shows that a hindered phenol is NOT a required component! Hindered phenols are only optional components according to Field et al's invention. In fact antioxidants themselves are only an optional component of Field et al's invention. All because Field et al's Abstract of the invention mentions an antioxidant as a component of the composition, does not mean that all disclosed compositions must have a hindered phenol. The composition given in Field et al's Abstract was given by way of illustration and not by way of limitation of compositions taught by Field et al. In any case, hindered phenols directly fall within the scope of corrosion inhibitors claimed in independent claims 1 and 31. Finally, Field et al also directly discloses that applicant's newly required diphenylamine antioxidant component, is an effective suitable antioxidant for Field et al's compositions, see page 12, lines 19-23.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

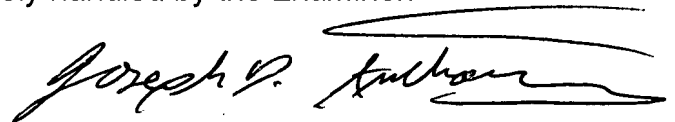
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1796

11/15/07